

## REMARKS

Applicant appreciates the thorough examination of the present application as evidenced by the Office Action dated November 3, 2003. Claims 1-19 are pending in this application. Claims 1-2, 4-12 and 14-19 stand rejected under 35 U.S.C. § 112, first paragraph, as purportedly not enabled. Claims 1-19 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. These rejections raised in the Office Action of November 3, 2003 will be addressed below.

### **I. Claim Rejections Under 35 U.S.C. § 112, First Paragraph, Enablement**

Claims 1-2, 4-12 and 14-19 stand rejected under 35 U.S.C. § 112, first paragraph, as purportedly not enabled. More specifically, the Office Action states that the specification "does not reasonably provide enablement for practicing the claimed method comprising the administration of antisense oligonucleotides." Office Action, page 2. Applicant respectfully disagrees with this assertion, however, in an effort to expedite prosecution, Applicant has amended the claims to cancel claims directed administration of antisense oligonucleotides. The cancellation of dependent claims is not intended to alter the meaning of the independent claims.

Accordingly, Applicant respectfully requests that the rejection of claims 1-2, 4-12 and 14-19 under 35 U.S.C. § 112, first paragraph, as lacking enablement, be withdrawn.

### **II. Claim Rejections Under 35 U.S.C. § 112, First Paragraph, Written Description**

Claims 1-19 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. More specifically, the Office Action states that "[t]he instant claims are drawn to methods comprising inhibiting EMAP II activity. . . . However, the specification as filed provides only a brief reference to human EMAP II according to GenBank Accession No. 10119. It is noted that the instant claims are not limited to human EMAP II, or furthermore human EMAP II according to GenBank Accession No. 10119." Office Action, pages 6-7. Applicant respectfully disagrees with this assertion, however, in an effort to expedite

prosecution, Applicant has amended the claims to include recitations directed to the treatment of human subjects, in which human EMAP II would, of course, reside. Human EMAP II is known. Support for these amendments can be found in the present application at page 12, line 37.

Accordingly, Applicant respectfully requests that the rejection of claims 1-19 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement, be withdrawn.

### **III. Provisional Obviousness-type Double Patenting Rejections**

Claims 1-19 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1-4 of copending U.S. Patent Application Serial No. 09/928,796 (the '796 application).<sup>1</sup>

As noted by the Examiner, the conflicting claims have not in fact been patented. Therefore, Applicant respectfully requests that this rejection be withdrawn and that the claims of the pending application be allowed. Applicant will provide a Terminal Disclaimer if it is determined to be necessary upon allowance of the relevant claims of the '796 application.

Accordingly, Applicant respectfully requests that the Examiner withdraw the stated provisional obviousness-type double patenting rejections.

### **Conclusion**

In view of the foregoing amendments and remarks, Applicant respectfully requests that all outstanding rejections to the claims be withdrawn and that a Notice of Allowance be issued in due course. The Examiner is invited and encouraged to contact the undersigned directly if such contact will expedite the prosecution of the

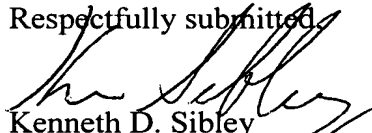
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<sup>1</sup> Attorney Docket No. 9022-8CT.

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pending claims to issuance. In any event, any questions that the Examiner may have should be directed to the undersigned, who may be reached at (919) 854-1400.

Respectfully submitted,



Kenneth D. Sibley  
Registration No. 31,665

**USPTO Customer No. 20792**  
Myers Bigel Sibley & Sajovec, P.A.  
P. O. Box 37428  
Raleigh, North Carolina 27627  
Telephone: (919) 854-1400  
Facsimile: (919) 854-1401

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Susan E. Freedman

Date of Signature: February 3, 2004